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**TRADEMARK TRIAL & APPEAL BOARD
IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re Application of: :
Rally Manufacturing, Inc. : Law Office: 109
Serial No. 78/576416 : Examining Attorney: Julie M. Guttadauro
Filed: February 28, 2005 : Atty Dkt: 8209.672
Mark: DURA GUARD

**APPLICANT'S REPLY TO EXAMINING ATTORNEY'S BRIEF
AND REQUEST FOR ORAL HEARING**

Trademark Trial and Appeal Board
Trademark Assistance Center
Madison East, Concourse Level Room C 55
600 Dulany Street
Alexandria, VA 22314

Dear Sir:

In further support of Applicant's appeal from the Final Refusal, and in reply to the Examining Attorney's Appeal Brief, Applicant submits the following remarks. In addition, Applicant requests an oral hearing on this appeal.

The Examining Attorney's primary arguments are that 1) the marks are similar, and 2) all vehicle accessories are related goods. The DuPont analysis is not so limited, however. Moreover, the ladder argument was specifically rejected by a trier of fact.

The Examining Attorney argues that the Applicant's goods and those listed in the '438 registration are closely related. Applicant respectfully disagrees. The Examining Attorney makes various legal arguments in support of her position, but fails to properly address the *Knaack Mfg.* case cited by Applicant. As noted in Applicant's initial Appeal

Brief, the *Knaack Mfg.* court found that there was no likelihood of confusion between the identical marks "WEATHERGUARD" in the automotive component market, holding that the products were not similar and rejecting the argument that any line of automotive product accessories may show similarity. *Knaack Mfg.*, 955 F. Supp at 1660. The court determined that although both products were automotive accessories, they were significantly dissimilar given they were functionally unrelated and non-competitive.

In response, the Examining Attorney simply argues that the examination of the likelihood of confusion in this case is based on the *Dupont* factors, while the factors used in the determination of trademark infringement are different factors. To prevail on a claim of trademark infringement, "a plaintiff must establish that (1) its mark is protectable and (2) the defendant's use of the mark is likely to cause confusion among consumers." *CAE, Inc. v. Clean Air Eng'g, Inc.*, 267 F.3d 660, 673-674 (7th Cir. 2001). Thus, likelihood of confusion is the central factual issue in a suit for trademark infringement. *Id.*

"The Court's ultimate conclusion on the likelihood of confusion is a question of fact." *Knaack Mfg.*, 955 F. Supp. at 999, citing *AHP Subsidiary Holding Company v. Stuart Hale Company*, 1 F.3d 611, 616 (7th Cir. 1993). "Because a trademark is an identifier rather than a property 'right,' the use of a competitor's mark that does not cause confusion as to source is permissible." *Libman Co. v. Vining Industries, Inc.*, 69 F.3d 1360, 1362 (7th cir. 1995). In evaluating likelihood of confusion, The *Knaack* court considered the following factors:

- 1) the degree of similarity between the marks in appearance and suggestion;
- 2) the similarity of the products for which the name is used;

- 3) the area and manner of concurrent use;
- 4) the degree of care likely to be exercised by consumers;
- 5) the strength of the complainant's mark;
- 6) actual confusion; and
- 7) an intent on the part of the alleged infringer to palm off its products as those of another.

Knaack Mfg., 955 F. Supp. at 999. Thus, the factors considered by the *Knaack* court are virtually identical to corresponding *Dupont* factors. Thus, the Examining Attorney's dismissal of the *Knaack* case is without merit, and fails to appreciate the analysis inherent in a trademark infringement case.

"The likelihood of confusion must be determined with reference to the realities of consumer behavior in the relevant market." *Knaack Mfg.*, 955 F. Supp. at 999, citing *Dorr-Oliver, Inc. v. Fluid-Quip, Inc.*, 94 F.3d 376, 381 (7th Cir. 1996). The trier of fact in *Knaack* made such a determination, and specifically rejected the argument that all vehicle accessories are related goods. As noted in Applicant's initial Appeal Brief, the goods at issue are functionally unrelated and not competitive; a consumer would not purchase a floor mat as a substitute for a vehicle cover; a consumer would not use a vehicle cover in connection with a floor mat; floor mats are for interior use of a vehicle, while vehicle covers are for exterior use. Moreover, there is no indication that the owner of the '438 registration sells floor mats for land vehicles, or any other type of mat for that matter. The Examining Attorney argues that such arguments are not convincing, dismissing similar distinctions found by the trier of fact in the *Knaack* case.

Instead, the Examining Attorney relies on the printouts from the USPTO X-Search database of third-party registrations in support of the refusal. On the other hand, the Examining Attorney also argues (with respect to those registrations cited by Applicant) that “Third-party registrations, by themselves, are entitled to little weight on the question of likelihood of confusion.” Examining Attorney’s Appeal Brief, p. 9. The Examining Attorney cannot rely on such evidence in support of her own position, while also asking the Board to disregard such evidence submitted by Applicant.

In any event, the submission of third party registrations and applications is probative of the strength and scope of a registration. See *PC Club v. Primex Techs., Inc.*, 32 Fed. Appx. 576, 579-580 (Fed. Cir. 2002) (“Third party registrations are relevant in determining whether a mark has appealed to others as a trademark element.”); *Bost Bakery, Inc. v. Roland Indus. Inc.*, 216 U.S.P.Q. 799, 801 n.6 (TTAB 1982) (Third party registrations are relevant in determining the distinctiveness of a mark); see also *General Mills, Inc. v. Kellogg Co.*, 824 F.2d 622, 626-27 (8th Cir. 1987) (“[E]vidence of third party usage of similar marks on similar goods is admissible and relevant to show that the mark is relatively weak and entitled to a narrower scope of protection.”)

With respect to the channels of trade, the Examining Attorney states that the Board has generally held that marketing by different parties of different types of parts and accessories under the same or similar marks is likely to cause confusion.” Examining Attorney’s Appeal Brief, p. 11. Again, such an argument is contrary to the evidence. Indeed, the Examining Attorney acknowledged that various registrations for either DURAGARD or DURAGUARD exist for various goods related to vehicles including oil filters, wear plates, hydraulic fluid and motor oil, but argues that “the goods are specific

enough in nature that they are not likely to be confused with one another”. Such a subjective determination is without merit and disregards the evidence of record.

While third party registrations may be considered when determining the scope of a registration, they are not relevant with respect to the scope of the goods in the registration. Rather, the Board looks “to the registration to determine the scope of the goods/services covered by the contested mark”, not to the goods sold by some third party. See *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 948 (Fed. Cir. 2000); see also *Canadian Imperial Bank of Commerce v. Wells Fargo Bank, Nat'l Ass'n*, 1 U.S.P.Q.2D (BNA) 1813, 1815 (Fed. Cir. 1987); *Commerce Drug Co. v. Kirkman Labs., Inc.*, 174 U.S.P.Q. (BNA) 265, 267 (CCPA 1972). “The description of the goods in an application for registration is critical because any registration that issues will carry that description.” *CBS, Inc. v. Morrow*, 708 F.2d 1579, 1581 (Fed. Cir. 1983). The goods listed in the ‘438 registration only include “semi-fitted and fitted covers for vehicles.” Registrant’s identification of goods does not include floor mats for land vehicles.

There is no basis for expanding the scope of the cited registration. To the contrary, Applicant has submitted extensive evidence establishing that the scope of the registration should be very narrowly construed. Indeed, the Examining Attorney even acknowledges that the cited mark is weak. See Examining Attorney’s Appeal Brief, p. 9.

Applicant submits that, when all of the *DuPont* factors are analyzed, there is no likelihood of confusion. In light of the arguments set forth herein, as well as those presented in Applicant’s Appeal Brief, reversal of the refusal is appropriate.

It is believed that no fees are due with this submission. Should that determination be incorrect, then please debit account 50-0548 and notify the undersigned.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'W. Schrot', written over the printed name.

William C. Schrot
Attorney for Applicant

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